

REMARKS/ARGUMENTSResponse to Arguments

The Examiner stated: "In view of the Appeal Brief filed on December 28, 2004, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2)."

In response, Applicant has elected to file this reply under 37 CFR 1.111.

Claim Rejections- 35 USC 103

The Examiner stated:

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Intel Pentium II \$20 mil intro (Intel launching Pentium II microprocessor worldwide on 5/7/97 backed by \$20 mil ad campaign)" Advertising Age, v68, n18, p 16 May 5, 1997, (hereinafter Advertising Age), in view of Houri U.S. Patent No 6,665,715 and further in view of Muret et al. US Patent No. 6,792,458.

Regarding claim 1 Advertising age teaches advertising media purchase placed in either of movies, video, television, print. etc., said media purchase including an Internet website address for accessing further information related to the subject matter of the media purchase, start date, end date and geographic area for the plurality of media purchases and tracking the Internet-

related goals achieved by the user (accessing the website) (see page 1). Advertising Age teaches the company launching an ad with a three days schedule in New York time, USA Today, The Wall Street Journal and handful of major metro papers. Page ads and spreads, starting May 19 in business magazines and computer publication. Advertising age teaches the company using one web address in print ads and another in banner ads to measure the effectiveness of each medium in driving the traffic to the site.

Adverting age failed to teach means for determining the geographic location associated with an Internet protocol address, means for grouping the geographic location into uniform stated geographic area, means for inputting and maintaining records in the database. Houri teaches means for determining the geographic location associated with IP address, grouping the geographic location into uniform stated geographic area, and a first database for storing IP address and corresponding geographic location, means for inputting and maintaining records in the database, means for accessing the database and assigning a stated geographic area. Houri teaches location tracking system used in a situation where a web site can provide appropriate information corresponding to the geographic location of the user visiting the site and providing reports illustrating the geographic dispersion of the website clientele, the report being accessible both on-line or on printable format (see abstract, fig 2, 6-9, col. 1 line 30 to col. 2 line 41, col. 3. lines 9-40, col. 7 lined 27-58, col. 8 line 50 to col. 9 line 3, and col. 13 line 27 to co. 14 line 42). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made to adapt tracking system as in Houri in Advertising Age's website and determine the geographical area of the users and correlate to stated geographic area and store the information in a system data base in order to provide the advantage taught by Houri, such as track the rate of responses to their advertisement and/or content and to improve marketing and provide relevant information corresponding to geographical location (see col. 1 lines 40-54 and col. 13 line 4 to col. 14 line 42). Advertising Age teaches running ads for specific days (three-day schedule), plurality of geographic locations (plurality of publications), use of web address on the ads and measuring the effectiveness of the each medium in driving traffic to the site i.e. tracking Internet-related goals (accessing the web site) achieved by the Internet user related to his accessing the

Internet website, however does not explicitly teach inputting the timing of occurrences of the Internet—related goals (user accessing the site). Muret teaches tracking web related goals and correlating and reporting the timing of Internet related goals, and providing report of activities of specific time period (see col. 1 line 54 to col. 2 line 32, col. 5 line 1 to col. 6 line 27 col. 7 line 4-15, col. 22 lines 5-60, col. 32 lines 56-68). It also would have been obvious to one of ordinary skill in the art at the time of the invention to implement tracking the timing of Internet—related goals as Muret, in Advertising Age's system (measuring effectiveness of ads that lead to a website), in order to track user's navigation within the website. One would be motivated to track the timing of the internet-goal in order to quickly assess which visitors are responsible for corresponding web server traffic and for advertiser to track how effective he banner ads are, and the location and behavior of shoppers, as taught by Muret (see col. 22 lines 28- 34 and col. 23 line 49 to col. 24 lines 33).

Regarding claims 2-8 Advertising Age does not teach report comprising a media type, media name stated geographic area, compiled continuously from start date to end date, and residual period, summary of Internet traffics summary of Internet-related goals, wherein the Internet goals comprise sales, downloads, etc., geographical representation etc. it is taught in Muret (see col. 12 lines 45-62, col. 19 lines 28-55, col. 23. lines 5-63, col. 26 line 23 to col. 29 line 29). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide such report, as taught in Muret in order to provide advertisers detailed or specific or summarized report, or report with a "date range", etc, depending on the report chosen by the advertiser or website owner in order to make valuable business decisions, as taught by Muret (see col. 21 line 16 to col. 23 line 41).

Applicant makes reference to the following citations:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made. 35 U.S.C. § 103(a) (emphasis added)

The legal determination under section 103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made ... Thus, each obviousness determination rests on its own facts. In re Mayne, 41 USPQ 2d 1451, 1453 (Fed. Cir. 1997) (emphasis added)

THE CLAIMED INVENTION AS A WHOLE MUST BE CONSIDERED

In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983) (Claims were directed to a vibratory testing machine (a hard-bearing wheel balancer) comprising a holding structure, a base structure, and a supporting means which form "a single integral and gaplessly continuous piece." Nortron argued the invention is just making integral what had been made in four bolted pieces, improperly limiting the focus to a structural difference from the prior art and failing to consider the invention as a whole. The prior art perceived a need for mechanisms to dampen resonance, whereas the inventor eliminated the need for dampening via the one-piece gapless support structure. "Because that insight was contrary to the understandings and expectations of the art, the structure effectuating it would not have been obvious to those skilled in the art." 713 F.2d at 785, 218 USPQ at 700 (citations omitted).).

See also *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) (Claims were directed to a three step process for preparing sweetened foods and drinks. The first two steps were directed to a process of producing high purity maltose (the sweetener), and the third was directed to adding the maltose to foods and drinks. The parties agreed that the first two steps were unobvious but formed a known product and the third step was obvious. The Solicitor argued the preamble was directed to a process for preparing foods and drinks sweetened mildly and thus the specific method of making the high purity maltose (the first two steps in the claimed process) should not be given weight, analogizing with product-by-process claims. The court held "due to the admitted unobviousness of the first two steps of the claimed combination of steps, the subject matter as a whole would not have been obvious to one of ordinary skill in the art at the time the invention was made." 535 F.2d at 69, 190 USPQ at 17 (emphasis in original). The preamble only recited the purpose of the process and did not limit the body of the claim. Therefore, the claimed process was a three step process, not the product formed by two steps of the process or the third step of using that product.)" MPEP 2141.02 (emphasis added)

There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie

case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification. *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (Claims were directed to an apparatus for producing an aerated cementitious composition by drawing air into the cementitious composition by driving the output pump at a capacity greater than the feed rate. The prior art reference taught that the feed means can be run at a variable speed, however the court found that this does not require that the output pump be run at the claimed speed so that air is drawn into the mixing chamber and is entrained in the ingredients during operation. Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).

The Applicant submits that the Examiner has not cited references that render the instant invention as a whole obvious. First, the references do not include each and every element of the instant invention. Missing elements are identified below.

1. An advertising media purchase. From the Advertising Age article, it is clear that the Intel's ad campaign was not intended to directly sell chips to end users. It is well known, and reflected in the article, that Intel sells chips to computer makers, who incorporate the chips into computers and sell them to end users. Intel's ad campaign was directed to business buyers and had to be, therefore, purely informational in nature: it was intended "to make Pentium II the standard in business PCs this year."¹
2. Placed in either of movies, video, television, interactive television, radio and print media. The Advertising Age article only mentions advertisements placed in print media and on banner ads².
3. Plurality of media purchases. The Advertising Age article deals only with a single ad campaign. There is no hint that Intel planned more than this campaign or that they intended to promote other than the Pentium II.
4. Residual period. The Advertising Age article talks about start dates for the ad campaigns and the end date for the US print campaign. But it says nothing about the residual period. As can be seen from the Figures of the instant invention, the residual period is a predefined period after the end date during which advertising may still be effective. In other words a user may see the media purchase on a date before the end date but may not respond to it until a date after the end date. It is highly useful to measure such "delayed" response. However, the Advertising Age does not recognize this fact.
5. Grouping of geographic locations into uniform stated geographic areas and a second database containing records correlating Internet Protocol addresses of Internet users with stated geographic areas. Houri does not teach grouping the geographic locations of IP addresses into uniform stated geographic areas. Houri includes much discussion about IP addresses, their geographic

¹1997

² It is well known that banner ads are placed on web pages.

locations and their connections but nowhere does Houri talk about grouping of geographic locations of IP address into uniform stated geographic areas.

Second, the references contain no suggestion to combine them as suggested by the Examiner. The Advertising Age article is simply a report and, as such makes no further suggestions of any sort. Houri obtains information by querying user terminals that are connected to the Internet. See Figure 1A. Muret et al. obtain their information "by reading log files produced by web servers or by interfacing with the web server in real time." See Abstract. Such disparate inventions cannot be combined in any meaningful way.

An additional fee of \$225 for response within the second month of extension is due. A credit card authorization for this amount is attached. Reconsideration of this application and its early allowance are respectfully requested in view of the above presented remarks.

Respectfully submitted,



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